UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,583	08/29/2000	Hirofumi Terada	500.38952X00	1012

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EXAMINER
LAZARO, DAVID R

ART UNIT	PAPER NUMBER
2155	8

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.		**Applicant(s)**
Office Action Summary	09/651,583		TERADA ET AL.
	Examiner		**Art Unit**
	David Lazaro		2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 April 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) <u>10-14</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☒ Claim(s) <u>1-9</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 August 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C.

121:

>   I.   Claims 1-9, drawn to a service processing apparatus for executing
>
>   information processing for supplying a service to a user, classified
>
>   in class 709, subclass 232.
>
>   II.   Claims 10-14, drawn to a method for measuring and comparing
>
>   usage of client terminals, and changing a use rate based on the
>
>   comparison, classified in class 709, subclass 224.

The inventions are distinct, each from the other because of the following reasons:

2.   Inventions group I and group II are related as combination and

subcombination. Inventions in this relationship are distinct if it can be shown that

(1) the combination as claimed does not require the particulars of the

subcombination as claimed for patentability, and (2) that the subcombination has

utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case,

the Invention in Group 1 has separate utility such as executing information

processing for supplying a service to a user. The invention in Group II has

separate utility because it provides a method of measuring the usage of client

terminals requesting services.

3.   Because these inventions are distinct for the reasons given above and

have acquired a separate status in the art because of their recognized divergent

subject matter, restriction for examination purposes as indicated is proper.

4.   Because these inventions are distinct for the reasons given above and the

search required for Group I is not required for Group II, restriction for examination

purposes as indicated is proper.

5.   During a telephone conversation with Carl Brundidge on 7/25/2003 a

provisional election was made with traverse to prosecute the invention of H.

Terada, et al., Claims 1-9. Affirmation of this election must be made by applicant

in replying to this Office action. Claims 10-14 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-

elected invention.

6.   Applicant is reminded that upon the cancellation of claims to a non-elected

invention, the inventorship must be amended in compliance with 37 CFR 1.48(b)

if one or more of the currently named inventors is no longer an inventor of at

least one claim remaining in the application. Any amendment of inventorship

must be accompanied by a request under 37 CFR 1.48(b) and by the fee

required under 37 CFR 1.17(i).

Claim Objections

7.   Claims 1-9 objected to because of the following informalities: They

appear to be a literal translation into English from a foreign document and are

replete with grammatical and idiomatic errors.   Claims 6 and 7 are especially

difficult to read. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   Claim 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

10.   Claim 7 recites the limitation "said means for executing information

processing " in lines 3 and 4. There is insufficient antecedent basis for this

limitation in the claim.

11.   Claim 8 recites the limitation "said means for executing" in line 1. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section
> 122(b), by another filed in the United States before the invention by the applicant for patent or
> (2) a patent granted on an application for patent by another filed in the United States before
> the invention by the applicant for patent, except that an international application filed under
> the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
> application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

12.   Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent 5,948,040 by David DeLorme et al. (DeLorme).

13.   With respect to Claim 1, DeLorme teaches a service processing apparatus

(Fig. 2 – 203) connected to a service requesting apparatus (Fig. 2 – 205, 227,

Col 14 lines 53-55) for requesting a service through a network for executing

information processing (Col. 13 lines 48-52) for supplying a service to a user who

uses said service requesting apparatus (Col. 13 lines 34-38), said service

processing apparatus comprising: means for receiving situation information(Fig.

2 – 205,227) indicative of a particular situation of said user (Col 7 lines 54-60),

means for receiving information related to said service, said information

transmitted from said service requesting apparatus (Fig. 2 –205, 227), means for

executing information processing for supplying said service based on said

received information (Col. 14 lines 1-52), and means for transmitting information

in a form corresponding to said situation information through said network (Col

15 lines 33-53).

14.   With respect to Claim 2, DeLorme teaches all the limitations as applied in

Claim 1 and further teaches the said situation information includes identification

information for identifying said service requesting apparatus (Col 32 lines 7-14),

and said means for transmitting transmits the information related to said

information processing in a form in accordance with a display capability of said

service requesting apparatus (Col. 15 lines 33-53) identified by said identification

information (Col 32 lines 11-14).

15.   With respect to Claim 3, DeLorme teaches all the limitations as applied in

Claim 1 and further teaches the said situation information includes moving

situation information indicative of a moving situation of said user (Col. 72, lines 2-

7), and said means for transmitting transmits the information related to said

information processing in a form in accordance with said moving situation (Col.

72 lines 7-15).

16.   With respect to Claim 4, DeLorme teaches all the limitations as applied in

Claim 3. It is inherent that DeLorme teaches the moving situation information

includes information for identifying transport means used by said user (Col. 75

lines 35-37, Col. 76 lines 46-53). DeLorme also teaches the information related

to said information processing to an information processing unit possessed by

said transport means (Col. 75 lines 33-37) is transmitted in a form corresponding

to the said information processing unit (Col. 72 lines 7-15).

17.   With respect to Claim 5, Delorme teaches all the limitations as applied in

Claim 1 and further teaches the means for transmitting transmits the information

related to said information processing to said service requesting apparatus

through said network (Col. 13 lines 48-52).

18.   Claims 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by

DeLorme.

19.   With respect to Claim 6, DeLorme teaches a service processing apparatus

(Fig. 2 – 209) connected through a network (Col. 13 lines 48-52) to a service

requesting apparatus (Fig. 2 – 205, 227, Col 14 lines 53-55) for requesting a

service, and to a plurality of service element processing apparatus (Fig. 2 - 221,

223, 213, 217) for executing information processing for each of the elements

constituting a service (See Col. 32 and 33 for detailed data descriptions of the

Fig. 2-221,223,213, and 217 blocks), said service processing apparatus

executing information processing for supplying a service to a user utilizing said

service requesting apparatus during movement (Col. 71 lines 61-67), comprising

means for receiving situation information indicative of a particular situation of said

user (Col. 72, lines 2-15), said information transmitted from said service

requesting apparatus (Col. 72, lines 7-15), and means for receiving service

requesting information for requesting supply of said service, said service

requesting information transmitted from said service requesting apparatus (Col.

72, lines 7-15), and means for forcing a service element processing apparatus

corresponding to said service request information to execute information

processing related to said element to execute information processing for

supplying a service in accordance with characteristics of said user based on said

executed information processing related to said element (Col. 31 lines 15-19),

and means for transmitting the result of said executed information processing

through said network in a form corresponding to said situation information (Col

15 lines 33-53).

20.   With respect to Claim 7, DeLorme teaches all the limitations as applied to

Claim 6 and further teaches the means for executing information processing

forces a service element processing apparatus having element information which

includes characteristics that match characteristics included in personal

information of said user (Col. 34 lines 26-31), to execute information processing

related to said element (Col. 31 lines 19-25),

21.   With respect to Claim 8, DeLorme teaches all the limitations as applied to Claim 6 and further teaches the said service comprises a service related to a travel (Col. 6 lines 56-60), and said element information includes information related to accommodation during a travel (Col. 58 line 54) and information related to transport means (Col. 61 line 24), and means for executing executes reservation processing for at least one of said accommodation and said transport means for said service element process apparatus (Col. 8 lines 33-48).

22.   With respect to Claim 9, DeLorme teaches all the limitations as applied to claim 8 and further teaches the said means for transmitting transmits the result of said executed information processing to said service requesting apparatus (Col 15 lines 33-53).

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24.   U.S. Patent 5,309,355, Lawrence Lockwood, "Automated Sales System", May 3, 1994

25.   U.S. Patent 5,648,900, James Bowen et al., "Method and apparatus for controlling and monitoring group travel related services." July 15, 1997

26.   U.S. Patent 5,832,451, Wayne Flake et al., "Automated travel service management information system." November 3, 1998

27.   U.S. Patent 5,839,114, Michael Lynch et al., "Automated system for selecting an initial computer reservation system." November 17,1998

28.   U.S. Patent 5,864,818, Ron Feldman, "Automated hotel reservation

processing method and sytem." January 26, 1999

29.   U.S. Patent 6,282,489, Keith Bellesfield, "Methods and apparatus for

displaying a travel route and generating a list of places of interest located near

the travel route." August 28, 2001.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to David Lazaro whose telephone number is

(703) 305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Hosain Alam can be reached on (703) 308 - 6662. The

fax phone numbers for the organization where this application or proceeding is

assigned are (703) 746-7239 for regular communications and (703) 746-7238 for

After Final communications.

Any inquiry of a general nature or relating to the status of this application

or proceeding should be directed to the receptionist whose telephone number is

(703) 305-3900.

David Lazaro
July 30, 2003

HOSAIN T. ALAM
PRIMARY EXAMINER